

Application # 09/436,432
Amendment Dated June 30, 2004
Reply to Office Action of December 31, 2003

IV. REMARKS/ARGUMENTS

7. The Office Action Dated December 31, 2003 has been carefully considered. Reconsideration of this application, as amended and in view of the following remarks, is respectfully requested.

8. Amendments to the specification were made to fix obvious clerical errors and were not made to overcome any issues of patentability.

A. References

9. The following U.S. patent was considered in the office action:

US Patent No. 5,721,815 ("Ottesen"), filed June 7, 1995.

10. The following International Application Publication was considered in the office action:

WO 99/59472 ("Figuredo"), published November 25, 1999, international application number PCT/US99/10894, which claimed priority based on U.S. provisional application 60/085,818 dated of May 18, 1998 and U.S. application 09/312,922 dated May 17, 1999 (Note that there was an error in the publication which cited 09/312,222)

11. Note that Figuredo and the invention of the present application were commonly owned or subject to common assignment at the time the present invention was made. The details of the common ownership will be discussed later in this response.

B. Overview of Office Action

12. The office action:

- a) rejected claims 1-3, 6-14, 16-17 and 19-33 under 35 U.S.C. 102(a), as being anticipated by Ottesen.

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- b) rejected claim 4-5, 15, 18, 23 and 34-35 under 35 U.S.C. 103(a) as being unpatentable over Ottesen as of claim 1 above, in further view of Figuredo.

C. Claim Rejections under 35 U.S.C. 102

13. The office action rejected claims 1-3, 6-14, 16-17 and 19-33 as being anticipated by Ottesen et al. (U.S. Patent No. 5,721,815).

Overview of Ottesen

14. Ottesen discloses a method and apparatus for effectuating transmission, reception, and processing of source program signals representative of a multimedia program, such as a movie, between a remote multimedia server and a plurality of local set-top control systems. A selected multimedia program is parsed into a customized series of discrete program segments where each segment a fixed, predetermined amount of video content, such as one second of video. The video is preferably compressed with a single compression format, such as MPEG-1 (which requires approximately 0.167 Mbytes, or 167 Kbytes, per second; 10:51-60). Typically the set-top systems do not store the entire movie but in order to provide VCR-like presentation controls, such as rewind and fast forward, stores video segments associated with a moving window of time. This moving presentation control window provides presentation control for only that portion of a multimedia program buffered in the direct access storage device (DASD). The buffering is provided using a novel DASD formatting methodology. The duration (or number of video segments buffered) of the presentation control window may be defined by the user prior to the start of transmission of any of the segments that make up the multimedia program. The novel DASD format of the set-top receiver is not the same as, or directly related to, the compression format used to compress the video on the multimedia server. When the user

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requests a portion of video not stored in the presentation control window (i.e. not buffered in the set-top DASD), the program segment must be retransmitted. When the program segment is retransmitted it is in the *exact same compression format* as the original transmission.

Overview of the Present Invention

15. The present invention discloses a method and apparatus for transmitting video images which allows a viewer to receive at the receiving display device a video stream of frames in a lesser quality, low-resolution, storage-efficient format (e.g. 150 Kbytes per second, page 14 line 20, which is comparable to MPEG-1's quality). After the viewer has seen at least a portion of the low quality video stream, the viewer is able to determine one or more sections of interest. The viewer then marks the beginning and end of each section of interest. After the viewer determines the sections of interest, a request is send to the transmitter to transmit the same section of interest, that was received in the *first low quality compression format*, in a much higher quality, high resolution, less-storage efficient *second enhanced (or high quality) compression format* (e.g. 2.5 Mbytes per second, page 15 lines 3-4, which is over 16 times larger, or higher quality, than the first low quality format). Note that the *duration* of the section of interest is *determined after* the video is transmitted in the first format, and that the *duration* of a section of interest is *arbitrarily marked* by the viewer based on interest after the video stream has been viewed.

16. While the first compression format is useful for selecting one or more areas of interest, the enhanced second format is required to provide significantly higher quality video, such as can be used for medical diagnosis.

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Differences Between Ottesen and the Present Invention

17. There are a number of differences between Ottesen's disclosure the present invention.

18. In a general sense, Ottesen is directed to household set-top systems that have relatively small disk space¹ (DASD) compared the size of the multimedia program, video, or movie that is being transmitted, and teaches that only a portion of a single program could ever be stored. In an home entertainment environment a single low quality format is sufficient. In contrast, the present invention is directed toward medical-quality, diagnostic video receivers that have relatively large disk space compared to the size of the video that is being transmitted. The present invention explicitly teaches that the entire video stream can be stored in the low-resolution first format and that the sections of interest can also be stored in the much larger, high-resolution second format. This general difference in itself limits Ottesen's ability to anticipate or make obvious the present invention. Ottesen also teaches away from the present invention in a number of ways as will be discussed below.

19. The following sections highlight specific elements that are missing from Ottesen.

Ottesen Does Not Teach a Second Enhanced Format

20. Ottesen fails to teach a second enhanced compression format. Ottesen repeatedly discusses only a single compression format. "The multimedia information transmitted

¹ For example, in one embodiment, "[a] subscribing customer's set-top control system 62 preferably includes a moderate amount of local storage, typically on the order of 5 to 10 megabytes, for receiving the compressed sequential video signal stream 46 transmitted from the multimedia server 30. Dynamic Random Access Memory (DRAM) or a DASD may be employed to buffer the 5 to 10 megabytes of the received compressed sequential video signal stream 46." (13:39-46, emphasis added)

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from the multimedia server 30 to a plurality of set-top control systems 62 is preferably transmitted in a digitally compressed format" (Ottesen 7:10-12). "Multimedia information is preferably stored in a compressed digital format" (8:18-19). "Multimedia programs ... are preferably ... compressed or coded in accordance with an established coding algorithm" (8:56-60). "[A]n analog video signal ... is preferably ... compressed by a coder 32 in accordance with an established coding algorithm" (9:10-14). "In a configuration employing an MPEG-1 coder 32, for example, video compression ratios of approximately 100:1 are typically achievable" (10:51-53). "In a preferred embodiment, the decoder 74 is configured to decode a compressed MPEG video bitstream" (22:61-63). See also Ottesen claims 10 ("a predetermined coding standard") and 17 ("a coder").

21. Throughout the specification Ottesen uses MPEG-1 as the preferred compression or coding algorithm. The video segments are only compressed once. They are transmitted in *a digitally compressed format*. They are stored in the *same digitally compressed format*. They are retransmitted in the *same digitally compressed format* if the segment has been over-written in the buffer in the set-top DASD. Ottesen fails to teach transmission of a second enhanced format, "wherein the second format represents an enhanced version of the first format".

22. Ottensen does mention MPEG-2, or others, as an alternate format for the *single* compression or coding algorithm, but never even suggests that a second compression format should be used to (re)transmit an enhanced version of an already compressed and transmitted program segment.

23. Applicant respectfully disagrees with the office action's conclusion that Ottesen's novel DASD formatting used to store the compressed video segments is a "second

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format, wherein the second format represents an enhanced version of the first format” as required by the claims of the present invention. The novel DASD formatting is directed to the manner in which the program segments are organized on the set-top’s DASD and is not the same type of formatting as compression format in which those program segments have been compressed on the multimedia server.

Ottesen Does Not Teach a Marked Portion of the Transmitted Video

24. Ottesen fails to teach a marked portion. In the present invention a portion of the transmitted video is marked after it has been transmitted and displayed to the user (page 12, lines 14-22; also page 8, lines 2-6). Typically, the marking is done by the viewer who uses an input device to select an arbitrary “mark in” and an arbitrary “mark out” which mark each area of interest (page 13, lines 17-25). The marked portion can include one or more sections of interest, each marked with a pair of markers. Alternatively the area of interest can be automatically determined by detecting that the user is lingering on a particular frame or group of frames (page 15, lines 23-26). Regardless of the method of marking, the plain meaning of the claim term requires some type of marks to indicate the beginning and end of the marked portion. Ottesen lacks this element.

25. Ottensen’s moving presentation control window is the same as or equivalent to a marked portion of transmitted video. As discussed above the presentation control window is determined prior to the transmission of the first program segment, not after transmission of the portion to be marked (e.g. as required by claim 1 and 7). The presentation control window is a predetermined duration, or length of time, which moves during transmission, not an portion, or section of interest, indicated by a pair of marks: an arbitrary, fixed starting mark and an arbitrary, fixed ending mark.

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26. An example of the *prior* determination of Ottesen's presentation control window can be seen in reference to Figures 21-27. In Fig. 21 at step 304 the duration of the presentation control window is determined (39:51-54). The parameters are sent at step 314 (Fig. 21, 40:53-56). However the first program segment is not transmitted until step 340 (Fig 22) which comes *after* several other steps (40:57 – 42:14).

Ottesen Does Not Teach a Request for an Enhanced Version

27. Ottesen fails to teach a request for an enhanced version. As discussed above Ottesen does not teach an enhanced second format, or a marked portion. Thus, it is impossible for Ottesen to teach "a request for an enhanced version of a marked portion" such as is required by claim 1 of the present invention. In some embodiments, the user explicitly selects an enhance function (page 13, lines 22-25). Ottesen fails to teach an enhance function or a request for an enhanced version.

Ottesen Does Not Teach a Re-transmission of the Marked Portion in a Second Format

28. Ottesen fails to teach re-transmission of a marked portion. As discussed above Ottesen does not teach an enhanced second format, or a marked portion. Thus, it is impossible for Ottesen to teach "transmitting the marked portion of the video stream of images in a second format, where the second format represents an enhanced version of the first format" such as is required by claim 1 of the present invention.

29. The only time Ottesen teaches retransmission of a program segment is when the viewer wants to rewind to a segment that is outside the presentation control window (i.e. no longer in the set-top buffer). This is exactly the opposite of teaching re-transmission of the marked portion. In this way, Ottesen teaches away from the present invention. Further, as discussed above, Ottesen does not teach a second format. Ottesen retransmits the program

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segment in the same, *single compression format*. Ottensen's motivation for retransmission is the fact that the program segments are no longer in the set-top buffer. In contrast, the present invention's teaches re-transmission of the section of interest precisely so the viewer can receive an *enhanced* version of the marked section of interest, which is still available and stored in the receiver.

Ottesen Teaches Away from Re-transmission of Stored Video

30. Ottesen teaches away from retransmission video that is already stored in the receiver. Ottesen explicitly teaches the desirability of transmitting each segment only once. "By transmitting each of the compressed video segments 48 generally only once, repetitive transmission of video segments 48 over the communication channel 44 that would otherwise be required to provide local VCR-type control over the media presentation is altogether avoided" (16:46-50). Ottesen further teaches, "As long as the viewer operates within the thirty minute presentation control window 90, each of the 7,200 compressed video segments 48 comprising the two-hour movie is transmitted only once from the multimedia server 30 to the subscriber's set-top control system 62. Moving outside of the presentation control window will generally require retransmission of previously transmitted compressed video segments 48. Such incidents of re-transmission preferably result in additional costs being charged to the subscriber's account." (21:1-10)

31. See also Ottesen 6:40-57 for a detailed teaching against having the transmitter retransmit any portion included in the presentation control window.

Ottesen Does Not Teach Adding Annotations to the Video Stream

32. Ottesen fails to teach adding annotations to the video stream. The operation codes shown in Fig. 18B are merely symbols used in the Figures to communicate the

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operation of Ottesen's novel DASD storage format. The symbols are defined at 30:53-65, and the operation is discussed at length in columns 30 through 39 in regard to the operation of the DASD on the set-top receiver. These are not the same as or equivalent to the annotations that are taught by the present invention wherein "a user can add annotations to the movie stored at the receiving device 106 and have those annotations sent to the transmitting device 103 or the server 150, as appropriate, and stored in the original movie file. This allows a user to annotate a movie which others download and view with the annotations" (page 16:12-15). Ottesen fails to teach annotations that are added with the motivation of changing the original movie.

Claim 1 Not Anticipated or Rendered Obvious by Ottesen

33. Regarding claim 1, Applicant respectfully disagrees with the examiner's conclusions that Ottesen discloses:

- a) a marked portion,
- b) a request for an enhanced version of a marked portion,
- c) a second format, wherein the second format represents an enhanced version of the first format,
- d) transmitting the marked portion in a second format.

34. For the reasons discussed in detail above, Ottesen does not teach a second enhanced format. Ottesen only teaches the use a single compression format that is used for all transmission, including retransmissions.

35. For the reasons discussed in detail above, Ottesen does not teach a marked portion of the transmitted video. Ottesen's presentations control window is a moving duration that is determined prior to transmission. Claim 1 requires that a portion of the transmitted video be marked after transmission. Ottensen fails to teach the required elements.

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36. For the reasons discussed in detail above, Ottesen does not teach a request for an enhanced version. Ottesen does not teach an enhanced second format, or a marked portion, making it impossible for Ottesen to teach "a request for an enhanced version of a marked portion" such as is required by claim 1.

37. For the reasons discussed in detail above, Ottesen does not teach a re-transmission of the marked portion in a second format. Ottesen does not teach an enhanced second format, or a marked portion, making it impossible for Ottesen to teach "transmitting the marked portion of the video stream of images in a second format" as is required by claim 1.

Claim 2 Not Anticipated or Rendered Obvious by Ottesen

38. Claim 2 is dependent on claim 1 and includes all of the required elements of claim 1. Applicant submits that claim 2 should be allowed for all the reasons cited above in relation to claim 1.

Claim 3 Not Anticipated or Rendered Obvious by Ottesen

39. Claim 3 is dependent on claim 1 and includes all of the required elements of claim 1. Applicant submits that claim 2 should be allowed for all the reasons cited above in relation to claim 1.

40. Further, claim 3 adds the limitation of "storing the marked portion of the video stream of images to replace a corresponding portion of the original video stream of images". As discussed in detail above, Ottesen fails to teach the marked portion or the transmission of the marked portion, thus also fails to teach that it should be stored to replace a corresponding portion. Also as discussed above, Ottensen only re-transmits a program segment when it is no longer in the set-top buffer; because the original portion is no longer at the

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receiving device, it would be impossible for Ottesen to teach regarding replacement of a corresponding portion.

Claim 6 Not Anticipated or Rendered Obvious by Ottesen

41. Claim 6 is dependent on claim 1 and includes all of the required elements of claim 1. Applicant submits that claim 6 should be allowed for all the reasons cited above in relation to claim 1.

Claim 7 Not Anticipated or Rendered Obvious by Ottesen

42. Claim 7 is dependent on claim 1 and 6 and includes all of the required elements of claim 1. Applicant submits that claim 7 should be allowed for all the reasons cited above in relation to claim 1.

43. Further, claim 7 adds the limitation of "marking the marked portion of the video stream of images at the receiving device". As discussed in detail above, Ottesen fails to teach the marked portion or the transmission of the marked portion, thus also fails to teach the marked portion may be marked after it is received. Ottesen fails to teach this required claim element.

Claim 8 Not Anticipated or Rendered Obvious by Ottesen

44. Claim 8 is dependent on claim 1 and 6 and includes all of the required elements of claim 1. Applicant submits that claim 8 should be allowed for all the reasons cited above in relation to claim 1.

Claim 9 Not Anticipated or Rendered Obvious by Ottesen

45. Claim 9 is dependent on claim 1 and includes all of the required elements of claim 1. Applicant submits that claim 9 should be allowed for all the reasons cited above in relation to claim 1.

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Claim 10 Not Anticipated or Rendered Obvious by Ottesen

46. Claim 10 is dependent on claim 1 and includes all of the required elements of claim 1. Applicant submits that claim 10 should be allowed for all the reasons cited above in relation to claim 1.

47. Further, claim 10 adds the limitation of "adding annotations to the video stream of images". As discussed in detail above, Ottesen fails to teach annotation that are added to the video stream of images. Ottensen's symbols used in Fig 18 to illustration the novel DASD organization and operation are not the same as or equivalent to the annotations of the present invention.

Claim 11 Not Anticipated or Rendered Obvious by Ottesen

48. Claim 11 is dependent on claim 1 and includes all of the required elements of claim 1. Applicant submits that claim 11 should be allowed for all the reasons cited above in relation to claim 1.

49. Further, claim 11 adds the limitation of "determining if a user views a particular image within the video stream of images for a predetermined period of time and automatically transmitting the particular image in the second format". As discussed above in detail, Ottesen fails to teach a transmitting "in the second format" and provides no teaching for "determining if a user views a particular image...for a predetermined period of time". Ottesen presentation control window is a predetermined period of time but there is not teaching that it is used to determine if a user has viewed a particular image for that predetermined period of time. This limitation of this claim simply is not taught or even suggested by Ottesen.

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Claim 12 Not Anticipated or Rendered Obvious by Ottesen

50. Claim 12 is dependent on claim 1 and includes all of the required elements of claim 1. Applicant submits that claim 12 should be allowed for all the reasons cited above in relation to claim 1.

51. Further claim 12 adds the limitation "wherein if the request for an enhanced version is received while the step of transmitting the video stream of images is being performed, then the step of transmitting the video stream of images is paused while the step of transmitting the marked portion is performed, and resumed once the step of transmitting the marked portion is completed". These limitation require "the request for an enhanced version", "transmitting the marked portion" and completion of the transmission of marked portion. As discussed in detail above, Ottesen fails to teach or suggest these limitations.

Claim 13 Not Anticipated or Rendered Obvious by Ottesen

52. Regarding claim 13, Applicant respectfully disagrees with the examiner's conclusions that Ottesen discloses:

- a) a request portion,
- b) a second format, wherein the second format represents an enhanced version of the first format,
- d) transmitting the request portion in a second format after transmitting transmitting in a first format.

53. For the reasons discussed in detail above, Ottesen does not teach a second enhanced format. Ottesen only teaches the use a single compression format that is used for all transmission, including retransmissions.

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54. For the reasons discussed in detail above, Ottesen does not teach a request portion of the transmitted video. Ottesen's presentations control window is a moving duration that is determined prior to transmission. Claim 13 requires that a requested portion of the transmitted video be transmitted after transmission in the first format. Ottensen fails to teach the required elements.

55. For the reasons discussed in detail above, Ottesen does not teach a request for an enhanced version. Ottesen does not teach an enhanced second format, or a requested portion, making it impossible for Ottesen to teach "transmitted to the receiving device in a first format and then a requested portion of the stream of images are transmitted to the receiving device in a second format" as is required by claim 13.

56. For the reasons discussed in detail above, Ottesen does not teach a re-transmission of the requested portion in a second format. Ottesen does not teach an enhanced second format, or a requested portion, making it impossible for Ottesen to teach "requested portion of the stream of images are transmitted to the receiving device in a second format" as is required by claim 13.

Claim 14 Not Anticipated or Rendered Obvious by Ottesen

57. Claim 14 is dependent on claim 13 and includes all of the required elements of claim 13. Applicant submits that claim 14 should be allowed for all the reasons cited above in relation to claim 13.

Claim 16 Not Anticipated or Rendered Obvious by Ottesen

58. Claim 16 is dependent on claims 13 and 14 and includes all of the required elements of claim 13. Applicant submits that claim 16 should be allowed for all the reasons cited above in relation to claim 13.

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Claim 17 Not Anticipated or Rendered Obvious by Ottesen

59. Claim 17 is dependent on claims 13, 14 and 16 and includes all of the required elements of claim 13. Applicant submits that claim 17 should be allowed for all the reasons cited above in relation to claim 13.

60. Further, claim 17 adds the limitation of "an input device for marking the requested portion of the stream of images". While Ottesen teaches an input device, the reference fails to teach the limitation that the input device is used "for marking the request portion". As discussed in detail above, Ottesen fails to teach any type of "marking" and fails to teach the "requested portion" for transmission in an "enhanced" "second format". Thus Ottesen fails to teach or make obvious the elements and limitations of claim 17.

Claim 19 Not Anticipated or Rendered Obvious by Ottesen

61. Claim 19 is dependent on claims 13, 14, 16 and 17 and includes all of the required elements of claims 13 and 17. Applicant submits that claim 19 should be allowed for all the reasons cited above in relation to claims 13 and 17.

Claim 20 Not Anticipated or Rendered Obvious by Ottesen

62. Claim 20 is dependent on claims 13, 14, 16 and 17 and includes all of the required elements of claims 13 and 17. Applicant submits that claim 16 should be allowed for all the reasons cited above in relation to claims 13 and 17.

63. The office action cites Fig 11/item 66 as a "received storage device". Applicant respectfully disagrees that the input buffer 66 has the capacity to store the stream of images. Ottesen teaches that the input buffer should "store at least twice the number of video segments contained in the largest video segment packet" (e.g. 2 times 5 program segments, or 10 seconds of a typically 2 hour movie).

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Claim 21 Not Anticipated or Rendered Obvious by Ottesen

64. Claim 21 is dependent on claims 13, 14, 16, 17 and 21 and includes all of the required elements of claims 13, 17, and 20. Applicant submits that claim 21 should be allowed for all the reasons cited above in relation to claims 13, 17, and 20.

65. Further, claim 21 adds the limitation "wherein the requested portion of the stream of images is stored in the second format and a remaining portion of the stream of images is stored in the first format at the received storage device." As discussed in detail above, Ottesen fails to teach "the requested portion" or "the second format" and thus fails to teach or render obvious the element of this claim. Further, as discussed in detail above, Ottesen only teaches retransmission when the program segment originally transmitted is longer in the buffer in the set-top receiver. Thus Ottesen teaches away from being able to store the "requested portion" with any type of "remaining portion". Ottesen fails to teach or render obvious the elements required by claim 21.

Claims 22, 24-28 and 29-33 Not Anticipated or Rendered Obvious by Ottesen

66. For all the reasons discussed in regard to claims 1-3, 6-14, 16-17, 19-21, the claims 22, 24-28 and 29-33 are not taught by Ottesen. Many of the required elements are missing. Also, for all the reasons discussed above, Ottesen fails to render obvious the elements of these claims.

67. Further regarding to claim 22, element (c) adds the limitation that after transmitting the video stream in the first format, the video stream is displayed "for a user to mark one or more sections of interest" and transmitting "a request" for "an enhanced version of the sections of interest" and receiving the "sections of interest...in a second format". Ottesen fails to disclose or suggest that a user can mark multiple sections (plural) of interest, or for a single

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request for multiple sections of interests to be transmitted in an enhanced version. Ottesen only has one presentation control window that is determined prior to any transmission. Again, Ottesen fails to provide any teaching regarding how a user can mark multiple sections of interest after the video stream is transmitted and displayed.

68. Further regarding to claim 29, element (b) adds the limitation that after transmitting the video stream in the first format, the video stream is displayed "allowing a user to mark sections of interest within the video stream" and element (c) adds the limitation of "transmitting the sections of interest" in the "second format". Ottesen fails to disclose or suggest that a user can mark multiple sections (plural) of interest, or for transmitting multiple sections of interests in an enhanced version. Ottesen only has one presentation control window that is determined prior to any transmission. Again, Ottesen fails to provide any teaching regarding how a user can mark multiple sections of interest after the video stream is transmitted and displayed.

69. Applicant submits that all the claims dependent on claims 22 and 29, respectively, should be allowed for all the reasons cited above in relation to claims 22 and 29, respectively.

D. Claim Rejections under 35 U.S.C. 103(a)

70. The office action rejected claims 4-5, 15, 18,23, and 34-35 under 35 U.S.C. 103(a), as being unpatentable over Ottesen as of claim 1, in further view of Figuredo.

Figuredo Does Not Have Prior Art Status

71. Figuredo and the invention of the present application were commonly owned or subject to common assignment at the time the present invention was made. See MPEP

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§ 706.02(l), specifically § 706.02(l)(1) through § 706.02(l)(3), and § 715.01, specifically 715.01(b).

72. I, Kendyl A. Román, hereby declares the following:

a) I am the primary inventor of the inventions disclosed in U.S. provisional application 60/085,818, filed of May 18, 1998. I first conceived and drew Figure 1 of the 60/085,818 application (from which Figure 2 of the present invention was derived). I assigned the 60/085,818 application to IntraCom Corporation.

b) I disclosed to Jonathan Owens other aspects of my inventions, which were disclosed in U.S. application 09/312,922, filed May 17, 1999 (which also contained a modified version of my original drawing).

c) I am listed as an inventor in Figuredo (WO 99/59472 published November 25, 1999, international application number PCT/US99/10894, which claimed priority based on U.S. provisional application 60/085,818 dated of May 18, 1998 and U.S. application 09/312,922 dated May 17, 1999). Figuredo also contains a modified version of my original drawing. The applicant in Figuredo was IntraCom Corporation.

d) I became a manager at IntraCom Corporation. I hired Carl P. Daniel and ensured that he executed a confidentiality agreement wherein he was under an obligation to assign any improvements or inventions to IntraCom Corporation. Under the confidentiality agreement, I disclosed to Mr. Daniel the details of my inventions including certain unimplemented features of my inventions. His work on those features resulted in the invention as now claimed in the present invention. At the time of the invention of the present application, US application

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60/085,818, Figuredo (WO 99/59472), and Mr. Daniel's improvements were subject to common assignment to IntraCom Corporation.

e) In accordance with his obligation, Carl P. Daniel assigned the present application to IntraCom Corporation (see attached assignment recorded on Reel 010537, Frame 0720).

f) On December 18, 2001, IntraCom Corporation assigned US applications 60/085,818, 09/312,922, 09/436,432 (the present application), and PCT/US99/10894 (Figuredo) to me, Kendyl A. Román (see attached assignment recorded on Reel 012585, Frame 0581).

g) Thus, Figuredo and the present application have always had common ownership, either IntraCom Corporation or Kendyl A. Román.

73. Applicant respectfully submits that the declaration of the above facts, and supporting assignment documents, should preclude any rejections which rely on Figuredo, or should be sufficient to overcome such rejections.

Claims 4-5, 15, 18, 23 and 34-35 Not Rendered Obvious by the Combination Ottesen and Figuredo

74. Even if Figuredo had status as prior art, as discussed above, Ottesen fails to teach or even suggest several of the required elements of independent claims 1, 13, 22 and 29, and their dependent claims. Further Ottesen teaches away from combination suggested by the office action. The suggested combination would not result in the claimed invention because the combination still lacks a "marked portion", a "second format", a "request of an enhanced version", a "step of adding annotations" which are all lacking in both Ottesen and Figuredo. Ottesen in further view of Figuredo would not render claims 4-5, 15, 18, 23, and 34-35 obvious.

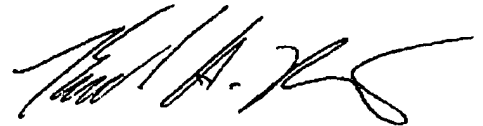
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75. Further claims 4-5, 18, 23, and 34-35, would all be patentable because they add limitations to the claims on which they are dependent. Applicant respectfully submits that even if Figuredo were prior art, claims 4-5, 18, 23, and 34-35 should be allowed for all the reasons cited above in relation the claims rejected base on anticipation by Ottesen.

V. RECONSIDERATION REQUESTED

76. The undersigned respectfully submits that, in view of the foregoing amendments and remarks, the rejections of the claims raised in the Office Action dated December 31, 2003 have been fully addressed and overcome, and the present application is believed to be in condition for allowance. It is respectfully requested that this application be reconsidered, that these claims be allowed, and that this case be passed to issue. If it is believed that a telephone conversation would expedite the prosecution of the present application, or clarify matters with regard to its allowance, the Examiner is invited to call the undersigned inventor at 408-739-9517.

Respectfully submitted,



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Sunnyvale, CA
Date: June 30, 2004